

**Supplement to the 2022 Edition of
Visser's Annotated European Patent Convention**

updated until 31.10.2022

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Introduction

This supplement is primarily for EQE 2023 candidates, taking into account the legal status cut-off date of 31.10.2022 (OJ 2017 A88). This supplement provides an overview of significant legal changes since the revision date of the 2022 print edition, i.e. between 01.03.2022 and 31.10.2022.

The online edition of Visser available on the Kluwer IP Law website - www.kluweriplaw.com - is regularly updated and includes full commentary on these updates as well as amendments in view of recent Technical Board of Appeal decisions and new information from the EPO website.

The next print edition of Visser will be published in Spring 2023. This will include commentary on the 2023 edition of the Guidelines for Examination in the EPO.

Art.55

In Art.55(1):4 (page 107) replace the list of exhibitions as follows (OJ 2022 A55):

01.10.2021 - 31.03.2022	Expo 2020	Dubai, United Arab Emirates
14.04.2022 - 09.10.2022	Floriade 2022	Almere, The Netherlands
20.05.2022 – 20.11.2022	XXIII Triennale	Milan, Italy
02.10.2023 - 28.03.2024	Expo 2023	Doha, Qatar
13.04.2025 - 13.10.2025	Expo 2025	Osaka, Japan

Art.60

In Art.60(1):1, second paragraph (page 134), replace the sentence “However, according to recent decisions by the examining division, the inventor must be a natural person, i.e. a human; an application attempting to designate an artificial intelligence as inventor will be refused (EP 3 563 896 A1; EP 3 564 144 A1)”

with: “However, according to J8/20 and J9/20, an inventor must be a natural person who has legal capacity and cannot be a machine having artificial intelligence.”

Art.75

In Art.75(1):2, last paragraph (page 162), replace “ADA.5.6.1-5.6.3” by “ADA.12.1-12.3”.

Art. 92

In Art.92:6 (page 224), add at the end of the note: “Since 01.09.2022, the EPO also carries out a top-up search to find any relevant national prior rights under Art.139(2) at the end of the grant proceedings and informs the applicant of any found national prior rights in the R.71(3) communication (EPO website news item 25.07.2022).”

Art.94

In Art.94(1):4.2 (page 230), update the following references to the PPH agreements:

AU OJ 2022 A58

CO OJ 2022 A88

Add a new agreement: SA OJ 2022 A59

Add a note that the agreement between the EPO and RU is suspended as of 25.04.2022 (OJ 2022 A44 and A45)

Art. 134a

In Art.134a(1):1, last paragraph (page 367), replace “ADA.9” by “ADA.16”.

Art.169

In Art.169:1.1 (page 401), add Montenegro to the list of contracting states (as of 01.10.2022) (OJ 2022 A78).

Add a note:

European patent applications filed on or after 01.10.2022 will include the designation of Montenegro. It will not be possible to designate Montenegro retroactively in applications filed before that date. However, to allow Montenegro to be designated, the EPO will accord European patent applications filed in September 2022 the filing date of 01.10.2022 if the applicant expressly requests that filing date when filing the application. Euro-PCT applications entering the European phase with an international filing date prior to 01.10.2022 will not include the designation of Montenegro as an EPC contracting state (OJ 2022 A78).

In Art.169:5 (page 404), add at the end of the note:

The Extension Agreement of Montenegro terminated on 30.09.2022. The extension system will, however, continue to apply to all European and international applications with a filing date prior to 01.10.2022, to divisional applications having a filing date before 01.10.2022 and to all European patents granted in respect of such applications (OJ 2022 A78).

R.2

In R.2(1):6, first paragraph (page 418), replace “ADA.5.1.2” by “ADA.7.1.2” and “ADA.5.6.1” by “ADA.12.1”.

In R.2(1):7, first paragraph (page 419), replace “ADA5.1.3” by “ADA.7.1.3”,

R.6

Add a new note R.6(6):1 (page 431):

1 Additional further processing fee

Where an applicant files a request for further processing under Art. 121 and invokes the fee reduction of R.6(3) after the expiry of the regular period to do so, the declaration under R.6(6) is also deemed late-filed, and another further processing fee under R.135(1) needs to be paid for it to be considered validly filed (J14/21).

R.12b

Add a new note R.12b(3):1 (page 438):

1 Code of Conduct for the BoA and EBoA members

The Presidium of the Boards of Appeal adopted the new Code of Conduct on 23 November 2021 after extensive review of similar documents (e.g., the Code of Conduct of the CJEU) and consultation with the Boards of Appeal Committee (BOAC). It replaces the previous Code of Conduct, which was limited to the external activities of board members. The Code of Conduct includes articles on its framework (Art.1), scope (Art.2), principles (Art.3), independency and integrity (Art.4), impartiality (Art.5), loyalty and diligence (Art.6), discretion (Art.7), external activities (Art.8), application of the Code of Conduct and Advisory Committee (Art. 9), freedom of expression (Art. 10), and duties of the members after ceasing to hold office (Art.11).

The Code of Conduct was approved by the Administrative Council on 14 December 2021 (CA/D 21/21) and entered into force on 1 July 2022. Full text of the Code of Conduct and the explanatory remarks thereto can be found in CA/68/21.

R.14

In R.14(1):1 (page 444), replace “A-VI,2.2.4” by “A-IV,2.2.4” (corrigendum).

R.30

In R.30:1, second paragraph, second sentence (page 462), add a reference to Not. EPO OJ 2022 A60.

R.79

In R.79:1, last paragraph (page 607), replace the first two sentences by:

“To reduce the number of documents transmitted by the EPO to the parties, the opposition division does not transmit to the parties copies of any documents annexed to notices of opposition or to letters which are available for inspection and for download in the Register (see R.143(1):2); paper copies are available only upon request (Not. EPO OJ 2022 A28).”

In R.79(1):1, first paragraph (page 607), add the following sentence in the end: “However, if the request for extension is denied by the opposition division, reasons for the denial should be provided (T2120/18 r.4.4).”.

R.100

In R.100(2):1 (page 630), replace the first paragraph by:

In *inter partes* appeal proceedings, the board communicates each party’s submissions (e.g. the notice of appeal, grounds of appeal and any response to the grounds of appeal) to the other parties. It also communicates any third party observations to all the parties. However, copies of documents cited by a party or a third party (including patent and non-patent literature) and attached documents containing amendments (such as an amended set of claims) are generally not forwarded and should instead be retrieved from the online file. They are, nevertheless, provided free of charge on request. Parties are informed of the filing of any item, such as a non-scannable object, which is not available for inspection in the online file. Parties are advised to check the online file in advance of oral proceedings to ensure that they are in possession of all relevant documents. (OJ 2022 A57)

R.103

In R.103:1 (page 635), add the following new last paragraph:

“If, following the lapse of a patent in opposition appeal proceedings, a party agrees to the termination of the appeal proceedings following a communication under R.84(1), this is to be regarded as equivalent to the withdrawal of the appeal and a reimbursement under R.103 is possible (T1548/15).”

R.112

In R.112(2):1, first paragraph (page 652), replace “ADA.4.1 and 5.5” by “ADA.7.5”.

R.114

In R.114(2):1, first paragraph (page 655), add the following sentence to the end: “Any annexes to the observation are available only in the Register (Not. EPO OJ 2022 A28).”

R.133

In R.133:2 (page 681), replace “ADA 5.1” by “ADA.7.1.2”.

R.134

In R.134(1):2, last paragraph (page 685), replace “ADA.5.5” by “ADA.11”.

In R.134(1):3.3, first and second paragraph (page 687), replace “ADA.5.5” by “ADA.11”.

R.141

In R.141(2):1, third paragraph (page 720), add CZ and replace “OJ 2021 A40” by “OJ 2022 A80”

R.152

In R.152(1):1, fourth paragraph’s first bullet point, second paragraph (page 739), replace “OJ 2019 sp4 Annex A1 §10.2” by ”OJ 2022 sp3 Annex A.1 10.3”.

R.154

In R.154:1 (page 744), replace “ADA.9” by “ADA.16”.

R.159

In R.159:3.1, first paragraph (page 753), replace “OJ 2017 SP5 p.7, point 2” by “OJ 2022 sp3 point 1”.

In R.159(1):5.1, last paragraph (page 763), replace “AAD.3.2(c)” by “AAD point 3 note I.3 in ADA Annex A.2”.

R.161

In R.161(1):3, second paragraph (page 772), replace “AAD.6.1(d)” by “notes to AAD point 3 note I.4, OJ 2022 sp3 Annex A.2”.

R.162

In R.162(2):2

- first paragraph (page 774), replace “AAD.6.1(e)” by “AAD.5.1(a)” and “sp5 OJ 2017 Annex A2 page 53 point 3(d)” by “notes to AAD point 3 note I.4 in ADA Annex A.2”.
- second paragraph (page 775), replace “AAD.6.1(h)” by “notes to AAD point 3 note I.4 in ADA Annex A.2”.

R.164

In R.164(1):2.3, fifth paragraph (page 782), replace “OJ 2017 sp5 Annex 2 page 40 Point 3(b)” by “OJ 2022 sp3 Annex A.2 point 3 note I.2”.

In R.164(2):2.3, third paragraph (page 785), replace “OJ 2017 sp5 p.49 §3(b)” by “OJ 2022 sp3 Annex A.2 point 3 note I.2”.

Rfees2

In Rfees2(1):1 (page 806), update the last sentence to read “The amounts of the PCT fees fixed by WIPO as of 01.07.2022 were revised as published in OJ 2022 A65.”.

In Rfees2(1):17 (page 812), update the references in the second paragraph by replacing “2021 A58” by “2022 A72” three times.

Rfees5

In Rfees5(2):1, first paragraph (page 818), replace “OJ 2019 sp4” by “ADA,OJ 2022 sp3”.

In Rfees5(2):2

- first paragraph (page 818), replace “The version valid as of 01.10.2019 is published in OJ 2019 sp4, amendments have been published in OJ 2020 A77, OJ 2021 A26 and A60” by “The version valid as of 10.09.2022 is published in OJ 2022 sp3”
- second paragraph (page 818), replace “ADA.5” by “ADA.7”, “ADA.5” by “ADA.7.1.2.” and “ADA.7” by “ADA.14”.
- fourth paragraph (page 818), replace “Online Fee Payment (ADA.4.2) and partially via Central Fee Payment” by “Central Fee Payment (ADA.6.2) as of 10.9.2022, and until that date, via Online Fee Payment (OJ 2022 A81)”
- last paragraph (page 818), replace “ADA.4.3” by “ADA.6.3”.

In Rfees5(2):2.1

- first paragraph (page 818), replace “ADA.5.1.2, amended by Dec. Pres. 18.03.2021, OJ 2021 A26 and Dec. Pres. 13.07.2021, OJ 2021 A60)” by “ADA.7.1.2”
- second paragraph (page 819), replace “ADA.5.1.3” by “ADA.7.1.3”
- third paragraph (page 819), replace “ADA.5.5” by “ADA.11”
- fourth paragraph (page 819), delete “(OJ 2017 sp5 p.4, §1.2)”
- fifth paragraph (page 819): replace “ADA.5.4.1” by “ADA.10.1, 10.2” and add “Debit orders are processed upon their receipt, provided there are sufficient funds on the deposit account (ADA 7.2.1).”
- replace the sixth paragraph (page 819) by the following two paragraphs:
“A debit order may be revoked as a whole or in part on its date of receipt by a written notice signed by the person making the payment and filed by email or as an attachment to an EPO online contact form (ADA.13.1). A debit order with a deferred payment date can be revoked via the Central Fee Payment at the latest the day preceding the specified payment date, or by a written notice filed by email or via the online contact form on the specified payment date (ADA.13.2). Debit orders with deferred payment date can be filed via Central Fee Payment as of 10.9.2022 (OJ 2022 A81).

Debit orders concerning multiple applications are processed in ascending order of application number, PCT preceding EP (for Euro-PCT applications, the EP number is used). Individual fees are booked in ascending order of fee codes, with appeal fee and opposition fee taking precedence over other fees. The page fee for EP application is booked together with the filing fee, despite its fee code. (ADA 7.3)”

- (original) seventh paragraph (page 819), replace “ADA.5.3; OJ 2019 sp4 Annex 3, OJ 2021 A61” by “ADA.9.1”
- last paragraph (page 819), replace “ADA.5.3.3” by “ADA.9.3”.

In Rfees5(2):2.1.1, first paragraph (page 819),

- replace “ADA.5.1.2 (amended by Dec. Pres. 18.03.2021, OJ 2021 A26 and Dec. Pres. 13.07.2021, OJ 2021 A60)” by “ADA.7.1.2”
- and delete the sentence “Account holders may notify any errors to the EPO; the EPO checks the information and makes any corrections necessary, retroactively to the original decisive payment date (ADA.4.2).”.

In Rfees5(2): 2.1.2

- first paragraph (page 820), replace “ADA.5.1. (ADA.5.6.1” by “ADA.12”
- second paragraph (page 820), replace “ADA.5.6.1; 5.6.2” by “ADA.12.1; 12.2”.

In Rfees5(2):2.1.3,

- first paragraph (page 820), replace “ADA.5.2; see example in OJ 2019 A21 §5” by “ADA.7.4.1”
- replace the second paragraph (page 820) by the following:
“After the deposit account is duly replenished, the EPO processes any pending debit orders (automatic debit orders taking precedence over other debit orders, ADA 7.4.2) and the payment is considered to have been made on the date of replenishment, not on the date of receipt of the debit order or the decisive payment date in case of automatic debiting (ADA.7.4.3). The date of replenishment is the date the payment was actually entered in the EPO bank account (Rfees7(1)). Hence, a shortfall may cause debit orders to be processed after expiry of the relevant period for payment and remedies for late paid fees may have to be applied. For late replenishment of a deposit account, see Rfees7(3):1.”
- last paragraph (page 820), replace the last sentence by “The EPO debits the account at the end of the day of the decisive payment date of a fee that must be debited automatically or on the date of receipt of the debit order for any other fee (ADA.7.2.1).”.

In Rfees5(2):2.2 (page 821), replace “OJ 2019 sp4 Annex B1 and B2” by “OJ 2022 sp3 Annex B.1 and B.2” and “ADA.9” by “ADA.16”.

In Rfees5(2):3

- replace the first paragraph (page 821) by: “An applicant or proprietor may file an automatic debit order according to the Arrangements for the Automatic Debiting procedure (AAD). The version of the AAD in force as of 10.09.2022 is published in OJ 2022 sp3 Annex A.1. Point 3.2(l) of the AAD comes into force on 01.11.2022. Explanations regarding the automatic debiting procedure are published in OJ 2022 sp3 Annex A.2.”
- replace the second paragraph (page 821) by: “An automatic debit order authorises the EPO to debit a deposit account for all fees due for an application or patent automatically on the due date of the fee. An automatic debit order must be filed and revoked online (AAD.1.2 and 10); recommended practice for revocation is given in notes to AAD.10 (OJ 2022 sp3 Annex A.2). On closure of a deposit account, the EPO revokes all pending automatic debit orders associated with the deposit account (AAD.10.4).”
- fourth paragraph (page 821), replace “(AAD.1.2, amended by Dec. Pres. 18.03.2021, OJ 2021 A26)” by “AAD.1.2” and “Automatic debit orders cannot yet be filed with the Central Fee

Payment (OJ 2021 A61)” by “Automatic debit orders can be filed with the Central Fee Payment as of 10.10.2022 (OJ 2022 A81).”

- fifth paragraph (page 821), add the following to the end of the paragraph: “Automatic debit orders are processed at the end of the day of the date of payment (ADA 7.2.1, AAD 4.4). The order for processing the fees is the same as for debit orders, see note 2.1 above, with the exception of opposition fee, which cannot be paid by automatic debiting. In case there was not sufficient funds on the deposit account on the decisive payment date, automatic debit orders take precedence over debit orders, once the account is replenished (ADA 7.4.2).”
- sixth paragraph (pages 821-822), replace all “OJ 2019 sp 4” by “OJ 2022 sp3” and “four days” by “two days”
- last paragraph (page 822), replace “ADA.5.2” by “AAD.4.5”.

Rfees7

In Rfees7(2):1 (page 824), replace “ADA.5.4.1” by “ADA.10.4.1 and “AAD.6.1(a)” by “AAD.5.1(a)”.

In Rfees7(3):1 (page 825), replace the last paragraph by:

“Regarding replenishment of deposit accounts, a payment by debit order is deemed to have been in time even if on the date of payment there were insufficient funds on the deposit account, provided the debit account holder ordered a SEPA credit transfer at least one day before or a SEPA instant credit transfer at least on the last day of the period for payment. For banks located in a contracting state not participating in the SEPA (currently Albania, Serbia and Turkey; Montenegro as of 01.10.2022), an order for replenishment of the deposit account at least three days before the expiry of the period for payment is deemed sufficient. (ADA.7.5 as of 10.09.2022)”.

In Rfees7(4):1, first paragraph (page 825), replace “ADA.4.1” by “ADA.7.5”.

Rfees9

In Rfees9:2, second paragraph (page 828), replace “ADA.8.2; OJ 2019 A82, amended by Dec. Pres. 18.03.2021, OJ 2021 A26” by “ADA.15.2”.